

Applications" is improper because the U.S. Patent Application Numbers and filing dates have not been supplied. In response, Applicant has amended pages 1 and 14 of the specification to fill in those blanks and make a correction.

The following is a summary of the examiner's rejections. Claims 1 and 5 were rejected by the examiner under 35 U.S.C. 103(a) as being unpatentable over Bartlett et al. (U.S. patent No. 6,263,382), Benmohamed et al. (U.S. Patent No. 6,240,463), Hayashi et al. (U.S. Patent No. 5,857,195), and Ong (U.S. Patent No. 5,815,662).

The examiner indicated that Bartlett et al. rendered obvious independent claim 1 by the following: "...obtaining at least one user defined workload requirement..." at col. 3, lines 19-21; and "...of said user defined workload requirement..." at col. 3, lines 19-21. Those lines 19-21 state: "The framework generates user-requested reports specific to system recommendations and attendant workload characteristics specified by the user." The framework is briefly described in lines 19-23 of col. 2 as: "Using a device implemented according to the invention, a framework for a computer system configuration device ("framework") provides a user interface and functionality common to a number of computer system configuration devices ("sizers") that are tailored for specific applications."

The examiner stated the Benmohamed teaches the calculation and display of requirements and the use of functions by the following: "...calculating the...requirements..." at col. 12, lines 30-34; "...as a function..." at col. 4, lines 49-53; and "...displaying...requirements..." at col. 13, lines 25-28. The examiner added that it would have been obvious to one ordinarily skilled in the art at the time of the invention to use the user input to calculate hardware requirements using mathematical equations or functions and then displaying the results of these calculations to the users in order to provide a system, which processes user input and provides feedback to the users on the effects of the input data on hardware models. In Benmohamed et al., lines 30-34 of col. 12 state: "Given the above-derived equations, the following are various embodiments of methodologies of the invention for calculating link capacity requirements relevant to the particular design criteria selected by the user of the network design system of the invention." Lines 49-53 of col. 4 state: "The output of the routing processor 12, denoted by reference designation A in FIG. 1, is routing information as a function of the demand flow and network topology, that is, the flow (traffic) found on each link or the f_i 's passing through each link." Lines 25-28 of col. 13 state: "Lastly, the link capacity requirements (denoted as reference designation B in FIG. 1) for each link of the current topology

are output to the user via, for example, a display associated with the processor 14." Benmohamed et al. disclose methods and apparatus for designing IP (internet protocol) networks with substantially improved performance as compared to existing IP networks such as, for example, those networks designed under best-effort criteria. They include includes methods and apparatus for: computing worst-case and optimistic link capacity requirements; optimizing network topology; and determining router placement within a network.

The examiner said that Hayashi teaches the use of database management systems by the following: "...database management system..." at col. 1, lines 29-33; and "...said database management system..." at col. 1, lines 29-33. Further, the examiner added, "It would have been obvious to one ordinarily skilled in the art at the time of the invention to use database management system (DBMS) requirements as requirements for a system in order to provide a standard method for using a computer system to store data and gain acceptance for the method of determining hardware requirements." Lines 29-33 of col. 1 state: "It is thus desired to take measures against the problem. In addition, there is a desire for techniques which make it possible for a user to easily tailor the structure of system definition data defining a database management system to suit the user's requirements."

The examiner indicated that Ong teaches the use of server hardware requirements by the language, "...server hardware requirements..." at col. 3, lines 10-15. The sentence of lines 10-15 in col. 3 states: "Thus, multiple requests for the same media program within a short time of each other, such as a popular title during Prime Time, can be handled with a minimum of accesses to the data storage device and with the minimum server hardware requirements and costs." The examiner said that it would have been obvious to one ordinarily skilled in the art at the time of the invention to use server hardware requirements in the specification of a computer system in order to provide requirements for the hardware components contain the database management system software, which processes query requests to databases and provides interface access for these queries and then returns the results of these queries to the users.

As to claim 5, the examiner stated that the "...a number of users supported...", is taught by Ong at col. 6, lines 9-11. These lines 9-11 state: "To better manage the availability of RAM and hence provide better service to a greater number of customers, the system of the invention tracks Title usage across time and..."

Claim 2 was rejected by the examiner under 35 U.S.C. 103(a) as being unpatentable over Bartlett, Benmohamed, Hayashi, and Ong as applied to claim 1 above, and further in view of Kulkarni

et al. (U.S. Patent No.6, 138,016). Additionally as to claim 2, the examiner indicated that the "...a plurality of inputs from a user....," is taught by Bartlett at col. 3, lines 19-21; the "...including a server type....," is taught by Bartlett at col. 3, lines 42-46; and the "...a maximum desired processor utilization....," is taught by Bartlett at col. 16, lines 25-29.

The examiner stated that Kulkarni teaches the use of transactions per second in the following sentence.

"To overcome the requirement of localizing the HLR in a single expensive machine, with a very high rate of messages per second and data base transactions per second, and according to this invention, the HLR function is distributed across multiple processors" (Col. 1, lines 58-62.)

The examiner added that it would have been obvious to one ordinarily skilled in the art at the time of the invention to use transactions per second to measure the throughput of processors in order to use a standard means of measurement to quantify the use of the processors.

Claim 3 was rejected by the examiner under 35 U.S.C. 103(a) as being unpatentable over Bartlett, Benmohamed, Hayashi, and Ong as applied to claim 1 above, and further in view of Tan et al. (U.S. Patent No. 6,356,902) Further, as to claim 3, the examiner said that the "...a number of processors requirement..." is taught by Bartlett at col. 11, lines 66-67,

and the "...and a mass storage requirement..." is taught by Bartlett at col. 8, lines 50-52.

The examiner indicated that Tan teaches the use of a memory size requirement in the following quote.

"Introducing null nodes has a harmful effect on the memory size requirement of virtual memory data processing systems, wherein fixed-length blocks of memory often referred to as "page" are utilized." (Col. 1, lines 55-59.)

Also, the examiner said, "It would have been obvious to one ordinarily skilled in the art at the time of the invention to use memory size requirement as a measure of physical blocks of memory used for storing data in order to use a standard feature of data storage architecture and obtain better acceptance of the method for determining server hardware requirements.

Claims 4 and 6 were rejected by the examiner under 35 U.S.C. 103(a) as being unpatentable over Bartlett, Benmohamed, Hayashi, and Ong as applied to claim 1 above, and further in view of Yamaji et al. (U.S. Patent No. 4,495,562). As to claim 4, the examiner indicated that Yamaji teaches the use of effective central processing unit (CPU) utilization in the following paragraph.

"As is apparent from the foregoing definitions, the progress rate coefficient of the job i is equal to the sum of the utilization $(CPU_i/ESTIME_i)$ for the CPU by each job and the

utilization ($IO_i/ESTIME_i$) for the I/O device by each job and is interpreted to be the net utilization of the job i . Therefore, the average progress rate coefficient is interpreted to be an average of the net utilization of each job, especially an effective average weight by the elapse time $ESTIME_i$ and the throughput coefficient is interpreted to be the total of the net utilizations of the respective jobs." (Col. 5, lines 24-34.)

The examiner stated, "It would have been obvious to one ordinarily skilled in the art at the time of the invention to use effective CPU utilization as a measure of activity of a CPU activity in order to use a commonly used means to determine the extent of processing being performed by the CPU."

As to claim 6, said that the "...an effective CPU utilization..." is taught by Yamaji at col. 5, lines 24-34, and the "...a number of users supported..." is taught by Ong at col. 6, lines 9-11.

Claim 7 was rejected by the examiner under 35 U.S.C. 103(a) as being unpatentable over Bartlett, Benmohamed, Hayashi, and Ong as applied to claim 1 above, and further in view of Blake et al. (U.S. Patent No. 6,067,412). As to claim 7, the examiner indicated that the "...and said properties include a calculated..." is taught by Benmohamed at col. 12, lines 30-34, the "...and a ratio of said calculated..." is taught by

Benmohamed at col. 12, lines 30-34, and the "...wherein said calculating step calculates values for said calculated...ratio...", is taught by Benmohamed at col. 12, lines 30-34.

The examiner stated that Blake teaches the use of a baseline system and transactions per second in the following statements.

"This information about the performance of the operating system is preferably generated during the construction of the model by using the synthetic workload generator to apply known workloads to a baseline computer system and using the actual performance measurements as an indication of the operating system performance."
(Col. 9, lines 44-48.)

"Thus, if the current CPU was replaced by a CPU that was twice as fast, the computer system still could only handle 2 transactions per second."
(Col. 2, lines 8-10.)

The examiner also said that it would have been obvious to one ordinarily skilled in the art at the time of the invention to use a baseline computer system in order to provide a standard reference to the workload of a computer to compare against actual workload performance. Likewise, the examiner added that it would have been obvious to one ordinarily skilled in the art at the time of the invention to use transactions per second to

measure the throughput of processors in order to use a standard means of measurement to quantify the use of the processors.

Claims 8-11 were rejected by the examiner under 35 U.S.C. 103(a) as being unpatentable over Bartlett, Friedrich et al. (U.S. Patent No. 5,276,877), Culley (U.S. Patent No. 5,125,088), and Garofalakis et al. (U.S. Patent No. 5,845,279), and Benmohamed. The examiner indicated that Bartlett rendered obvious independent claim 8 by the following language:
"...obtaining at least one input from a user..." at col. 3, lines 19-21; and "...obtaining from said user..." at col. 3, lines 19-21.

The examiner stated that Friedrich teaches the use of transactions, and the use of workload contributions as follows:
"...a plurality of transactions..." at col. 11, lines 44-52;
"...wherein each of said transactions have..." at col. 11, lines 44-52; "...a transaction..." at col. 11, lines 44-52; "...workload contribution..." at col. 26, lines 18-23; "...calculating a total workload..." at col. 19, lines 29-32; "...transaction..." at col. 11, lines 44-52; "...workload contribution..." at col. 26, lines 18-23; "...and transaction..." at col. 11, lines 44-52; and "...of said transactions..." at col. 11, lines 44-52.
The examiner said that it would have been obvious to one ordinarily skilled in the art at the time of the invention to use transactions as basic units of processor throughput in order

to use standard quantifiable units. The examiner added that, likewise, it would have been obvious to one ordinarily skilled in the art at the time of the invention to use the workload contribution of these transactions in order to differentiate between the various inputs used to determine the processing capability of a computer system.

The examiner indicated that Culley teaches the use of expected execution rates in the following excerpts: "...and an expected execution rate per second..." at col. 19, lines 55-62; and "...execution rate..." at col. 19, lines 55-62. The examiner further indicated that it would have been obvious to one ordinarily skilled in the art at the time of the invention to use expected execution rates in order to define a model for a baseline computer system and compare the baseline model with the actual results obtained.

The examiner said that Garovalakis teaches calculating total workloads as follows: "...calculating...as a function..." at col. 8, lines 6-8 and col. 8, lines 24-28; and "...said total workload..." at col. 14, lines 27-29. The examiner added that it would have been obvious to one ordinarily skilled in the art at the time of the invention to calculate total workloads in order to determine the workload on a computer system, which is defined as the total contribution of all the transactions used in this model.

The examiner indicated that Benmohamed teaches displaying the results of the calculations to users in the language of "...and display...to said human user " at col. 13, lines 25-28. The examiner further indicated that it would have been obvious to one ordinarily skilled in the art at the time of the invention to display the results of calculations to the users in order to provide feedback to the users on the effects of the input data on hardware models.

As to claim 9, the examiner stated that the "...include a server type..." is taught by Bartlett at col. 3, lines 42-46.

As to claim 10, the examiner said that the "...maximum desired processor utilization..." is taught by Bartlett col. 16, lines 25-29.

As to claim 11, the examiner indicated that the "...maximum desired...utilization..." is taught by Bartlett col. 16, lines 25-29 and the "...network interface card..." is taught by Bartlett at col. 3, lines 47-54.

Claim 12 was rejected by the examiner under 35 U.S.C. 103(a) as being unpatentable over Bartlett, Friedrich, Culley, Garofalakis, and Benmohamed as applied to claim 8 above, and further in view of Schumacher et al. (U.S. Patent No. 6,032,664).

As to claim 12, the examiner said that the "...a server type..." is taught by Bartlett at col. 3, lines 42-46; the

"...a maximum desired processor utilization...", is taught by Bartlett col. 16, lines 25- 29; the "...a maximum desired...utilization...", is taught by Bartlett col. 16, lines 25-29; and the "...network interface card...", is taught by Bartlett at col. 3, lines 47-54.

The examiner stated that Schumacher teaches the use of LAN speeds as follows:

"The Remote Node method requires less equipment and software than the Remote Control method, and the remote user's application executes the same as if he were working directly on one of the LAN's nodes with the only difference being communication speed versus LAN speed." (Col. 2, lines 50-54.)

Further, the examiner said that it would have been obvious to one ordinarily skilled in the art at the time of the invention to use LAN speed in the calculations for the throughput of a multi-computer system in order to use to speed of communications between the processors when determining the throughput of the system.

Claims 13 and 14 were rejected by the examiner under 35 U.S.C. 103(a) as being unpatentable over Bartlett, Friedrich, Culley, Garofalakis, Benmohamed, and Schumacher as applied to claim 8 above, and further in view of Reiner et al. (U.S. Patent No. 6,289,334). As to claim 13, the examiner indicated that the "...each of said transactions...", is taught by Friedrich at

col. 11, lines 44-52; the "...wherein each of said transaction...", is taught by Friedrich at col. 11, lines 44-52; the "...workloads...", is taught by Friedrich at col. 26, lines 18-23; the "...are calculated by calculating...", is taught by Benmohamed at col. 12, lines 30-34; the "...a workload contribution...", is taught by Friedrich at col. 26, lines 18-23; the "...and wherein a percent contribution...", is taught by Friedrich at col. 26, lines 18-23; and the "...of total workload is specified...", is taught by Friedrich at col. 19, lines 29-32.

The examiner said that Reiner teaches the use of SOJ statements as follows:

"The QD SORT building block is structurally similar to the AGGREGATE building block: it has QD-generated SQL statements to create a temporary sort table, insert rows in that table, select rows in sorted order from that table, and drop the table when it is finished with it." (Col. 67, lines 15-19.)

The examiner also said that it would have been obvious to one ordinarily skilled in the art at the time of the invention to use SQL statements when determining the throughput of a computer system in order to use the basic command statements of a database management system language to help determine the throughput of a computer system using a database management system.

As to claim 14, the examiner indicated that the "...said SOL statements...", " is taught by Reiner at col. 67, lines 15-19; the "...include insert...", " is taught by Reiner at col. 56, lines 36-39; the "...delete...", " is taught by Reiner at col. 67, lines 23-25; the "...update...", " is taught by Reiner at col. 64, lines 29-31; the "...and select...", " is taught by Reiner at col. 56, lines 36-39; and the "...SOL statement types...", " is taught by Reiner at col. 67, lines 15-19.

Claim 15 was rejected by the examiner under 35 U.S.C. 103(a) as being unpatentable over Bartlett, Friedrich, Culley, Garofalakis, Benmohamed, Schumacher, and Reiner as applied to claim 14 above, and further in view of Berenson et al. (U.S. Patent No. 6,356,887).

As to claim 15, the examiner said that the "...said insert SOL types...", " is taught by Reiner at col. 56, lines 36-39; the "...have parameters...", " is taught by Reiner at col. 56, lines 36-39; the "...including...insert statements...", " is taught by Reiner at col. 56, lines 36-39; the "...and wherein said insert statement...", " is taught by Reiner at col. 56, lines 36-39; the "...SOL workload contribution...", " is taught by Friedrich at col. 26, lines 18-23; the "...is a function...", " is taught by Reiner at col. 53, lines 10-14; the "...of said statement parameters...", " is taught by Reiner at col. 56, lines 36-39; the "...said delete SOL types...", " is taught by Reiner at col. 67,

lines 23-25; the "...have parameters...", is taught by Reiner at col. 56, lines 36-39; the "...including...delete statements...", is taught by Reiner at col. 67, lines 23-25; the "...and wherein said delete statement...", is taught by Reiner at col. 67, lines 23-25; the "...SQL workload contribution...", is taught by Friedrich at col. 26, lines 18-23; the "...is a function...", is taught by Reiner at col. 53, lines 10-14; the "...of said statement parameters...", is taught by Reiner at col. 56, lines 36-39; the "...said update SQL types...", is taught by Reiner at col. 64, lines 29-31; the "...have parameters...", is taught by Reiner at col. 56, lines 36-39; the "...including a number of records...", is taught by Reiner at col. 10, line 67 and col. 11, lines 1-2; the "...to be operated on...", is taught by Reiner at col. 37, lines 2-4; the "...by said update statement...", is taught by Reiner at col. 64, lines 29-31; the "...and wherein said update statement...", is taught by Reiner at col. 64, lines 29-31; the "...SQL workload contribution...", is taught by Friedrich at col. 26, lines 18-23; the "...is a function...", is taught by Reiner at col. 53, lines 10-14; the "...of said statement parameters...", is taught by Reiner at col. 56, lines 36-39; the "...and said select SQL types...", is taught by Reiner at col. 56, lines 36-39; the "...have parameters...", is taught by Reiner at col. 56, lines 36-39; the "...including selectivity criteria...", is taught by Reiner at

col. 29, lines 57-61; the "...and wherein said select statement...", is taught by Reiner at col. 56, lines 36-39; the "...SQL workload contribution...", is taught by Friedrich at col. 26, lines 18-23; the "...is a function...", is taught by Reiner at col. 53, lines 10-14; and the "...of said statement parameters...", is taught by Reiner at col. 56, lines 36-39.

The examiner stated that Berenson teaches the use of a number of identical statements as follows: "...When those applications issue a large number of simple statements, compilation time can become the dominant cost factor" at col. 1, lines 54-56; and "...Such an unsafe execution plan will only be reused if an identical statement is received..." at col. 13, lines 43-45. The examiner also stated, "It would have been obvious to one ordinarily skilled in the art at the time of the invention to use the number of identical statements with insert statements and delete statements in order to simplify the calculation associated with determining the throughput of a system having a database management system."

The Applicant respectfully disagrees with the rejections or in some instances with the bases of the rejections. To recap; in essence, this office action appears to reveal a different style of examination that the Applicant has not previously encountered. The rejection of many elements of the claims

appears to have been done with seemingly isolated references, and in some instances the rejection of various portions of the same element was effected by different references or by different unconnected parts of the same reference. In some places of a rejection, a single term or word in an element was rejected with an isolated portion of a reference. Some of the cited portions or terms of the reference appeared to be taken out of context. Many of the references did not all appear to be from the same field of art of the present invention or even relative to each other. The suggestion or the motivation for combining elements or terms from the several or many various cited references might be regarded as being readily apparent to the Applicant. In this light, one could go to a technical encyclopedia, dictionary, patent database or the net and search for the terms or elements of claims for rejection purposes.

Often, a statement of obviousness of a combination relative to a rejected element or term of a claim appeared to be conclusory in that the specific suggestion or motivation for the combination was not clearly pointed out or stated. Further, there appeared to be no evident suggestion in the cited art or motivation for the combining many of the referred-to parts of the numerous references cited to reject a claim, or for the total combination of "old" elements or terms from the references being asserted in the rejection of the respective claim. It

appears then that any claim with elements or portions of elements findable in some prior art would not be allowable. It seems to follow that it would be futile to amend a rejected claim if a newly added limitation or portions of it were somehow existent anywhere in the prior art.

The following information and cases are cited here to support the Applicant's position even though the Examiner may be well aware of them. Because an element can be found somewhere in a prior art, analogous or not, does not mean that the claim is unallowable. "As this court [the Federal Circuit] has stated, 'virtually all [inventions] are combinations of old elements.' Environmental Designs, Ltd. v. Union Oil Co., 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed. Cir. 1983); see also Richdel, Inc. v. Sunspool Corp., 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed. Cir. 1983) ("Most, if not all, inventions are combinations and mostly of old elements."). Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an

approach would be "an illogical and inappropriate process by which to determine patentability." Sensonics, Inc. v. Aerosonic Corp., 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996)." In re Rouffet, 47 USPQ 1453, 1457 (Fed. Cir. 1998).

The following case, though not necessarily binding precedent, seems to suggest that if a claim is not allowable, that a rejection preferably be based on fewer references. "The examiner concluded that applicant's invention would have been obvious in light of twelve references. The Board correctly stated that the examiner's reliance on so many references was "overkill" and concluded that applicant's invention would have been obvious in light of four of the references. We agree with the Board on the former statement, but disagree with the latter. What both the examiner and Board have done is to cite a number of references variously containing some of the limitations in applicant's claims. However, these references and the limitations for which they were cited were combined piecemeal without any suggestion or motivation for their combination and without regard to the purpose of applicant's invention. . . ." In re Blamer, Civ. App. No. 93-1108, slip op. at 3-4 (Fed. Cir. Sept. 21, 1993) (unpublished).

"When relying on numerous references or a modification of prior art, it is incumbent upon the examiner to identify some suggestion to combine references or make the modification. In

re Jones, 958 F.2d 347, 351, 21 USPQ2d 1941, 1943 (Fed. Cir. 1992) (stating that there must be some suggestion to combine, "either in the references themselves or in the knowledge generally available to one of ordinary skill in the art"); see Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 292, 227 USPQ 657, 664 (Fed. Cir. 1985)." In re Mayne, 41 USPQ2d 1451, 1454 (Fed Cir. 1997).

"The factual inquiry whether to combine references must be thorough and searching." Id. [McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001)] It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. See, e.g., Brown & Williamson Tobacco Corp. v. Philip Morris Inc., 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000) ("a showing of a suggestion, teaching, or motivation to combine the prior art references is an 'essential component of an obviousness holding'") (quoting C.R. Bard, Inc., v. M3 Systems, Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998)); In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references."); In re Dance, 160 F.3d 1339,

1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) (there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant); In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) ("teachings of references can be combined only if there is some suggestion or incentive to do so.") (Emphasis in original) (quoting ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984))." In re Lee, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

The suggestion or motivation for combining various references should be specific. "The need for specificity pervades this authority. See, e.g., In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed"); In re Rouffet, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ("even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious."); In re Fritch, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed.

Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references")." In re Lee, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002).

"Our case law makes clear that the best defense against hindsight-based obviousness analysis is the rigorous application of the requirement for a showing of a teaching or motivation to combine the prior art references. See In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). 'Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight.' Id." Ecolochem Inc. v. Southern California Edison Co., 56 USPQ2d 1065, 1073 (Fed. Cir. 2000). As noted in In re Fritch, 23 USPQ 2d 1780, 1784 (Fed. Cir. 1992), it is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. The court has stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." (quoting In re Fine, 837 F.2d 1071, 1075, 5 USPQ 2d

1596, 1600 (Fed. Cir. 1988). To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher. W.L. Gore & Associates, Inc. v. Garlock, Inc., 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

The cited reference should be analogous prior art. "To ascertain the scope of the prior art, a court examines 'the field of the inventor's endeavor,' Shatterproof Glass Corp. v. Libbey-Owens Ford Co., 758 F.2d 613, 620, 225 USPQ 634, 638 (Fed. Cir. 1985), and 'the particular problem with which the inventor was involved,' Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 1535, 218 USPQ 871, 876 (Fed. Cir. 1983) (quoting In re Wood, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979)), at the 'time the invention was made,' see 35 U.S.C. § 103(a)." Monarch Knitting Machinery Corp. v. Sulzer Morat GmbH, 45 USPQ2d 1977, 1981 (Fed. Cir. 1998).

An instance of art appearing to be analogous, e.g., memories, but not so, was discussed by the Federal Circuit in the following. "The Allen-Bradley art is not in the same field of endeavor as the claimed subject matter merely because it relates to memories. It involves memory circuits in which

modules of varying sizes may be added or replaced; in contrast, the subject patents teach compact modular memories." Wang Laboratories, Inc. v. Toshiba Corp., 26 USPQ 2d 1767, 1773 (Fed. Cir. 1993). Further, "Wang's SIMMs were designed to provide compact computer memory with minimum size, low cost, easy repairability, and easy expandability. . . . In contrast, the Allen-Bradley patent relates to a memory circuit for a larger, more costly industrial controller. . . . Thus, there is substantial evidence in the record to support a finding that the Allen-Bradley prior art is not reasonably pertinent and is not analogous." Id.

Some of the statements regarding obviousness of a certain element or elements of a claim in view of cited references appeared to be conclusory. "'Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'" Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617." Ecolchem Inc. v. Southern California Edison Co., 56 USPQ2d 1065, 1073 (Fed. Cir. 2000).

The Applicant respectfully requests that the claim examination process used by the Examiner in the present office action be reconsidered in view of the concerns stated above by the Applicant. The Applicant also respectfully requests

reconsideration of the pending claims, and allowance of these
claims.

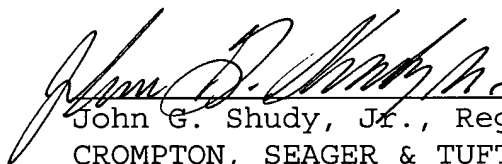
Respectfully submitted,

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9/23/02



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Version With Markings to Show Changes Made

In the Specification

The paragraph beginning at page 1, line 5 has been amended as follows:

The present application is related to U.S. Patent Application Serial No. 09/515,308[____], filed February 29, 2000[____], entitled DATABASE SIZER FOR NT SIZER SYSTEM; U.S. Patent Application Serial No. 09/514,801[____], filed February 29, 2000[____], entitled COMBINATION OF MASS STORAGE SIZER, COMPARATOR, OLTP USER DEFINED WORKLOAD SIZER, AND DESIGN TRADE-OFF TOOL IN ONE PACKAGE; U.S. Patent Application Serial No. 09/515,158[____], filed February 29, 2000[____], entitled BUILT IN HEADROOM FOR AN NT SYSTEM SIZER; U.S. Patent Application Serial No. 09/516,272[____], filed February 29, 2000[____], entitled ALGORITHMS TO CALCULATE MASS STORAGE REQUIREMENTS FOR NT SIZER; and U.S. Patent Application Serial No. 09/514,506[____], filed February 29, 2000[____], entitled METHOD OF COMPARISON FOR COMPUTER SYSTEMS AND APPARATUS THEREFOR, all of which are assigned to the assignee of the present invention and incorporated herein by reference.

The paragraph beginning at page 14 line 1 has been amended as follows:

The mass storage required 222 can also be determined by method 200. The mass storage required can be satisfied by adding the appropriate size and number of mass storage devices such as disk drives. The required mass storage can be calculated using the methods described in related applications U.S. Patent Application Serial No. [_____]09/516,272, filed [_____]February 29, 2000, entitled ALGORITHMS TO CALCULATE MASS STORAGE REQUIREMENTS FOR NT SIZER, and U.S. Patent Application Serial No. [_____]09/515,308, filed [_____]February 29, 2000, entitled DATABASE SIZER FOR NT SIZER SYSTEM, herein incorporated by reference. The tpmC ratio 226 provides a means for comparing the system specified by the inputs to method 200 and a baseline system tpmC 214 provided by the user. In one embodiment, a top window in the application program can be used to selectively browse through the tpmC database. The browsing can be filtered based on the operating system and database management system. In one embodiment, the tpmC database is filtered according to operating system and DBMS to provide a shorter list, which is selectable via a drop down list to a single tpmC database record, which can be termed the "baseline" system. The tpmC value from the record can be used

as the value for the baseline system. In some embodiments, a known system from one vendor is selected as the baseline system on one part of the screen. The requirements can be used to select for another system, termed the 'target' system, from a second vendor in another part of the screen. The tpmC of the target system can be compared to the tpmC of the baseline system using ratio 226.